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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,369	12/10/2004	Francis Pinault	Q8-492	3960
23373 7590 09/02/2008 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
EXAMINER NICKERSON, JEFFREY L.				
ART UNIT		PAPER NUMBER		
2142				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/517,369

**Applicant(s)**

PINAULT ET AL.

**Examiner**

JEFFREY NICKERSON

**Art Unit**

2142

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to Application No. 10/517,369 filed nationally on 10 December 2004 and internationally on 13 June 2003. The request for continued examination presented on 08 July 2008, which provides change to claims 1 and 12, is hereby acknowledged. Claims 1-22 have been examined.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first transmission channel, second transmission channel, voice data, and configuration data must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

3. The drawings are objected to under 37 CFR 1.84(o). The drawings should clearly identify items of the invention without reference to the specification. Items 4, 5, 7, 2, 6, 1, 8, 9 (Figure 1) and 4, 9, 1, 2 (Figure 2) should be clearly identified with either a legend or proper labels identifying their purpose. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be

canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. **The objection(s) to the drawings will not be held in abeyance.**

#### ***Claim Objections***

4. Claims 1-22 are objected to for having parenthesized reference characters in the claims that create indefiniteness.

Regarding claims 1-22, these claims contain parenthesized reference characters such as "(PLMN)" and "(RP)", which create ambiguity as to whether these are actual limitations. Exemplary language renders a claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

***Response to Arguments***

5. Applicant's arguments, filed 08 July 2008, with respect to the rejection(s) of claim(s) 1-22 under 35 USC 102(e) as being anticipated by Mani (US 2002/0188725 A1) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mani (US 2002/0188725 A1), and in further view of Clark (US 5,490,251) and Katinakis et al (US 6,389,039 B1).

Regarding claim 1, Mani teaches a communication server for making services offered by a private second communication network available to terminals connected to a first communication network and able to exchange signaling data on a first transmission channel and voice data on a second transmission channel simultaneously in

accordance with a selected protocol (Mani: Figure 5, items 514, 508, 502; [0032]; Figure 1, item 104),

which server is characterized in that it comprises control means adapted to send to a terminal connected to the first network, configuration data to enable said terminal to setup a connection with said server, so as to make at least some of said services offered by said second network available to said terminal (Mani: abstract, Figure 3, item 306).

Mani does not teach sending configuration data on the first channel during a voice connection between at least two users on said second channel, so as to make services available during said voice connection.

Clark, in a similar field of endeavor, teaches sending configuration data on the first channel (Clark: abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Clark for sending data over a signaling channel. The teachings of Clark, when implemented in the Mani system, will allow one of ordinary skill in the art to authenticate users over a signaling channel instead of the bearer channel. One of ordinary skill in the art would be motivated to utilize the teachings of Clark in the Mani system in order to conserve network resources.

The Mani/Clark system does not teach wherein data on another channel is being sent during a voice connection between at least two users on said second channel, so as to make services available during said voice connection.

Katinakis, in a similar field of endeavor, teaches wherein data on another channel is being sent during a voice connection between at least two users on said second channel, so as to make services available during said voice connection (Katinakis: abstract, col 5, lines 16-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Katinakis for simultaneous voice and data transmissions. The teachings of Katinakis, when implemented in the Mani/Clark system, will allow one of ordinary skill in the art to send authentication data over a signaling channel while a voice connection is using the main bearer channel. One of ordinary skill in the art would be motivated to utilize the teachings of Katinakis in the Mani/Clark system in order to allow users to access both voice and data services simultaneously.

Regarding claim 2, the Mani/Clark/Katinakis system teaches wherein the control means are adapted to send configuration data to a terminal when said terminal has set up a connection with said server using a selected primary identifier, setting up said connection constituting said selected criterion (Mani: [0021] and [0012]).

Regarding claim 3, the Mani/Clark/Katinakis teaches wherein said control means are adapted to effect an identification procedure before sending said configuration data (Mani: [0012]).

Regarding claim 4, the Mani/Clark/Katinakis system teaches wherein the server comprises

a memory (database) in which secondary identifiers are stored (Mani: [0012] specifies a user access profile; [0010] indicates the access profile can hold more than one identifier to verify against);

and in that said control means are adapted to send to said terminal identification data which (Mani: abstract specifies invoking an access service application),

once installed in said terminal, enables the automatic sending to said server (Mani: [0049] specifies that interrogation can occur without user interaction)

of at least one secondary identifier stored in a memory of said terminal (Mani: [0012] specifies more than one multimedia response used for verification)

and then to compare the received secondary identifier with identifiers stored in said memory and then to send said configuration data to said terminal if the identifiers are identical (Mani: [0012] specifies allowing access only after one or more identifiers are verified against the database that contains user profiles).

Regarding claim 5, the Mani/Clark/Katinakis system teaches wherein said control means are adapted to send security data (interrogation) to the terminal after said configuration data (Mani: [0044] specifies that interrogations can occur after the network resource is being accessed).



Regarding claim 6, the Mani/Clark/Katinakis system teaches wherein the said secondary identifier represents the user of said terminal (Mani: [0012] specifies live picture IDs and speech samples).

Regarding claim 7, the Mani/Clark/Katinakis system teaches wherein the said configuration data and/or said identification data constitutes a script or an applet (Mani: abstract specifies the identification data is interrogated and processed with an access service application).

Regarding claim 8, the Mani/Clark/Katinakis system teaches wherein said configuration data is adapted, in the event of activation by the user of the terminal, (Mani: abstract specifies the user indicates)

to prompt (interrogate) said user to provide at least one tertiary identifier and to send a registration request (access attempt) containing at least said tertiary identifier to said control means (Mani: [0039] specifies different types of authentication techniques) on the first channel (Clark: abstract),

in that said memory stores said primary identifiers in corresponding relationship to at least one tertiary identifier, and in that said control means are adapted, on the receipt of a registration request, to send to said configuration data a request for the transmission of at least one primary identifier associated with said terminal, and then, on reception of said primary identifier, to compare the primary identifier and the tertiary identifier previously received to the identifiers stored in said memory in order to

authorize or refuse said registration as a function of the result of this comparison (Mani: [0037]-[0042] specify a database cluster that holds profile information with multiple identifiers and the possibility of cascading interrogation to receive multiple levels of authentication, where the database server could be available to both the private and public networks and the interrogation responses are verified against the user access profiles).

Regarding claim 9, the Mani/Clark/Katinakis system teaches wherein

said configuration data is adapted, in the event of reception of a call request message from the first network by said terminal (Clark: col 6, lines 35-50),

to extract certain information from said message and to send that information to said control means via said first channel (Katinakis: abstract and col 5, lines 16-22 provide for bidirectional communication of any data over signaling),

and in that said control means are adapted, on receipt of said information, to process it as a function of its content and then send to said terminal on said first channel a message selected as a function of the processing applied and the information received (Clark: col 6, lines 56-65).

Regarding claim 10, the Mani/Clark/Katinakis system teaches wherein

said configuration data is adapted, after the terminal has been registered and in the event of an attempt by said terminal to call a remote terminal (Mani: [0010], [0042]; Clark: col 6, lines 9-20),

to inhibit access to the first network and to send information including at least the primary identifier of the remote terminal to said control means on said first channel, (Clark: col 6, lines 56-65);

and in that said control means are adapted, on receipt of said information, to process it as a function of its content (Mani: [0042]),

and then to send to said terminal on said first channel a message selected as a function of the processing applied and the information received and comprising at least one call authorization or prohibition (Mani: [0042]),

and information to be displayed on the screen of said terminal (Mani: [0008] specifies the user terminal is a multimedia appliance; [0020] specifies multiple possibilities of multimedia, such as presentation of text),

so that on reception of said message said configuration data either removes the inhibition on access to the first network with a view to setting up the call or prohibits the call (Mani: [0042]).

Regarding claim 11, this server claim comprises limitations found within claim 9 and the same rationale of rejection is used, where applicable. And wherein said control means are adapted to process the information received from said terminal after registering the terminal (Mani: [0044] specifies that additional interrogation and processing of those interrogations may occur after the original access is granted).

Regarding claim 12, this method claim comprises limitations corresponding to that of claim 1 and the same rationale of rejection is used, where applicable.

Regarding claim 13, this method claim comprises limitations corresponding to that of claim 2 and the same rationale of rejection is used, where applicable.

Regarding claim 14, this method claim comprises limitations corresponding to that of claim 3 and the same rationale of rejection is used, where applicable.

Regarding claim 15, this method claim comprises limitations corresponding to that of claim 4 and the same rationale of rejection is used, where applicable.

Regarding claim 16, this method claim comprises limitations corresponding to that of claim 5 and the same rationale of rejection is used, where applicable.

Regarding claim 17, this method claim comprises limitations corresponding to that of claim 6 and the same rationale of rejection is used, where applicable.

Regarding claim 18, this method claim comprises limitations corresponding to that of claim 7 and the same rationale of rejection is used, where applicable.

Regarding claim 19, this method claim comprises limitations corresponding to that of claim 8 and the same rationale of rejection is used, where applicable.

Regarding claim 20, this method claim comprises limitations corresponding to that of claim 9 and the same rationale of rejection is used, where applicable.

Regarding claim 21, this method claim comprises limitations corresponding to that of claim 10 and the same rationale of rejection is used, where applicable.

Regarding claim 22, this method claim comprises limitations corresponding to that of claim 11 and the same rationale of rejection is used, where applicable.

***Cited Pertinent Prior Art***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- a. Anderson (US 2002/0039904 A1) discloses a system with data over signaling features.
  - b. Evans (US 6,311,060 B1) discloses a system with data over signaling features.
  - c. Duvall et al (US 6,876,858 B1) discloses a system with data over signaling features.
  - d. Smith et al (US 7,027,809 B1) discloses a system with data over signaling features.
  - e. Feiertag et al (US 5,625,677) discloses a system with simultaneous voice and data communications.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY NICKERSON whose telephone number is (571)270-3631. The examiner can normally be reached on M-Th, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. N./  
Jeffrey Nickerson  
Examiner, Art Unit 2142

/Andrew Caldwell/  
Supervisory Patent Examiner, Art Unit 2142